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10/532,877

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EXAMINER

VO, HAI

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,877	Applicant(s) BAYRAM-HAHN ET AL.	
	Examiner Hai Vo	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, and 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The art rejections based on WO 01/77660 have been withdrawn in view of the present amendment.
2. The 102 rejections over EP 838 257 are changed to the 102/103 rejections in view of the present amendment.
3. The 102 rejections over WO 98/58253 are changed to the 102/103 rejections in view of the present amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, and 12-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim contains an improper hybrid combination. The preamble is directed to a molding while the body of the claim is related to a combination of a molding and a cladding material.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4, 5, 14, 16, 17, 19, 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 838 257. EP '257 discloses a monolithic molding for chromatographic separation made from a porous inorganic body coated with a polymeric material (column 3, lines 10-25). The porous inorganic body is silica, alumina (column 4, line 4). The coating is styrene/divinylbenzene, methacrylic acid derivatives that are physically adsorbed on the porous silica shaped body (claim 2). The molding is columnar and has a diameter of 0.254 cm (example 1). EP'257 does not specifically disclose the processing steps as set forth in the claims, having a cladding on the long side of the molding during the coating, impregnating with a coating solution, and the organic polymer forced through the molding under pressure and afterward lowering the temperature. However, they are product-by-process limitations not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of EP'257 is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If

the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with EP'257. Accordingly, EP'257 anticipates or strongly suggests the claimed subject matter.

9. Claims 3, 15, and 18 and rejected under 35 U.S.C. 103(a) as being unpatentable over EP 838 257 as applied to claim 1 above, and further in view of WO 98/58253. Cabrera et al (US 6,398,962) will be relied on as an equivalent form of WO 98/58253. EP '257 does not specifically disclose the monolith having macropores and mesopores and its length. Cabrera however discloses a monolithic moulding for chromatographic separation made from a porous shaped SiO₂ body having interconnected macropores and mesopores in the walls of macropores wherein the macropores have an average pore size of greater than 0.1 microns and the mesopores having an average pore size of 2 nm to 100 nm (column 2, lines 20-25). Cabrera '962 discloses that the molding is columnar, having a diameter of 1 cm or greater and a length of 9.3 cm (column 3, lines 20-22, example A1). Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to use the porous monolith of Cabrera '962 for the chromatographic separation motivated by the desire to provide high flow rates at a moderate operating pressure, thereby achieving improved productivity.

10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 838 257 as applied to claim 1 above, and further in view of Dhingra et al (US 6,054,052). EP'257 does not specifically disclose the flat monolithic sorbent and its thickness. Dhingra, however, teaches a porous inorganic sorbent in the form of a flat membrane having a thickness 0.02 to 1000 microns, encompassing the claimed range (column 25, lines 1-8; column 24, lines 5-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a porous inorganic monolithic in the form of flat membrane with a thickness as taught by Dhingra because such a thickness is sufficient for the inorganic sorbent in performing the efficiency of the separation.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 838 257 as applied to claim 1 above, and further in view of Li et al (US 7,125,448). EP' 257 does not specifically disclose the monolithic being modified with a copolymer of tetraalkoxysilane and methyltrialoxysilane. Li, however, teaches a silica monolith having surface modified with at least two silanes wherein one silane is an endcapping silane (abstract, column 16, lines 25-35, and table 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous silica monolith having surface treated with

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the silanes as described by Li motivated by the desire to retain polar analytes reproducibly under highly aqueous conditions.

12. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 838 257 as applied to claim 1 above, and further in view of Ohno et al (US 4,483,940). EP '257 does not specifically disclose the coating including polymer (2-hydroxyethyl methacrylate). Ohno, however, teaches a coated monolithic material comprising a silica monolith coated with polymer (2-hydroxyethyl methacrylate) (column 4, lines 10-20). The coating polymer is present in an amount of 0.02% to 10% by weight (column 4, lines 48-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymer (2-hydroxyethyl methacrylate) as a coating material for the porous silica monolith because it has been shown in the art that polymer (2-hydroxyethyl methacrylate) is a typical form of the polyacrylate that could be widely used as a coating for the silica monolith. EP'257 does not specifically disclose the carbon content. However, it appears that EP'257 as modified by Ohno uses the same coating material and the same concentration of the coating material as Applicants and the carbon content depends from such a concentration. Therefore, it is not seen that the carbon content could have been outside the claimed range.

13. Claims 1-5, 14-19, 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/58253. Cabrera et al (US 6,398,962) will be relied on as an equivalent form of WO 98/58253. Cabrera discloses a monolithic molding for chromatographic separation

made from a porous shaped SiO₂ body having interconnected macropores and mesopores in the walls of macropores wherein the macropores have an average pore size of greater than 0.1 microns and the mesopores having an average pore size of 2 nm to 100 nm (column 2, lines 20-25). The molding is coated with adsorption polymers such as styrene/divinylbenzene, methacrylic acid derivatives (column 4, lines 20-25). The molding is columnar and has a diameter of 1 cm or greater (column 3, lines 20-22). The molding has a length of 9.3 cm (example A1). Cabrera does not specifically disclose the processing steps as set forth in the claims, having a cladding on the long side of the molding during the coating, impregnating with a coating solution, and the organic polymer forced through the molding under pressure and afterward lowering the temperature. However, they are product-by-process limitations not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Cabrera is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the

claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Cabrera. Accordingly, Cabrera anticipates or strongly suggests the claimed subject matter.

14. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 as applied to claim 1 above, and further in view of Dhingra et al (US 6,054,052). Cabrera does not specifically disclose the flat monolithic sorbent and its thickness. Dhingra, however, teaches a porous inorganic sorbent in the form of a flat membrane having a thickness 0.02 to 1000 microns, encompassing the claimed range (column 25, lines 1-8; column 24, lines 5-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a porous inorganic monolithic in the form of flat membrane with a thickness as taught by Dhingra because such a thickness is sufficient for the inorganic sorbent in performing the efficiency of the separation.

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 as applied to claim 1 above, and further in view of Li et al (US 7,125,448). Cabrera does not specifically disclose the monolithic being modified with a copolymer of tetraalkoxysilane and methyltrialoxysilane. Li, however, teaches a silica monolith having surface modified with at least two silanes wherein one silane

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is an endcapping silane (abstract, column 16, lines 25-35, and table 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous silica monolith having surface treated with the silanes as described by Li motivated by the desire to retain polar analytes reproducibly under highly aqueous conditions.

16. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 as applied to claim 1 above, and further in view of Ohno et al (US 4,483,940). Cabrera does not specifically disclose the coating including polymer (2-hydroxyethyl methacrylate). Ohno, however, teaches a coated monolithic material comprising a silica monolith coated with polymer (2-hydroxyethyl methacrylate) (column 4, lines 10-20). The coating polymer is present in an amount of 0.02% to 10% by weight (column 4, lines 48-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymer (2-hydroxyethyl methacrylate) as a coating material for the porous silica monolith because it has been shown in the art that polymer (2-hydroxyethyl methacrylate) is a typical form of the polyacrylate that could be widely used as a coating for the silica monolith. Cabrera does not specifically disclose the carbon content. However, it appears that Cabrera as modified by Ohno uses the same coating material and the same concentration of the coating material as Applicants and the carbon content depends from such a concentration. Therefore, it is not seen that the carbon content could have been outside the claimed range.

17. Claims 1-3, 5, 14-19, 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as

anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 100 30 665. Lubda et al (US 2003/0172674) will be relied on as an equivalent form of DE 100 30 6650. Assuming that the compliant amendment in next response requires a cladding material be part of the molding. Lubda discloses a monolithic molding for chromatographic separation made from a porous inorganic body having a surface modified with epoxides and the modified porous inorganic body subsequently coated with hydrophobic polymer layers (column 3, lines 10-25). The inorganic porous monolithic molding comprises silica. The surface modification reads on Applicant's cladding. The hydrophobic polymer comprises polysiloxane which is mechanically or covalently bonded to the glass surface (paragraph 41). The inorganic porous monolithic molding is prepared by the same sol gel process disclosed in WO 98/29350. Therefore, it is the examiner's position that the bimodal pores structure with mesopores and macropores, the shape, the length would be inherently present.

Lubda does not specifically disclose the processing steps as set forth in the claims. However, they are product-by-process limitations not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Lubda is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product

itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Lubda. Accordingly, Lubda anticipates or strongly suggests the claimed subject matter.

18. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 100 30 665 as applied to claim 1 above, and further in view of WO 98/58253. Cabrera et al (US 6,398,962) will be relied on as an equivalent form of WO 98/58253. Lubda does not specifically disclose the modified inorganic monolithic being coated with a polystyrene and/or polymethacrylate. Cabrera, however, teaches a monolithic molding for chromatographic separation, made from a porous shaped SiO₂ body having interconnected macropores and mesopores in the walls of macropores wherein the macropores have an average pore size of greater than 0.1 microns and the mesopores having an average pore size of 2 nm to 100 nm (column 2, lines 20-25). The molding is coated with adsorption polymers such as

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styrene/divinylbenzene, methacrylic acid derivatives (column 4, lines 20-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous silica monolith coated with the styrene/divinylbenzene, methacrylic acid derivatives by the desire to improve the separation properties.

19. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 100 30 665 as applied to claim 1 above, and further in view of Dhingra et al (US 6,054,052). Lubda does not specifically disclose the flat monolithic sorbent and its thickness. Dhingra, however, teaches a porous inorganic sorbent in the form of a flat membrane having a thickness 0.02 to 1000 microns, encompassing the claimed range (column 25, lines 1-8; column 24, lines 5-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a porous inorganic monolithic in the form of flat membrane with a thickness as taught by Dhingra because such a thickness is sufficient for the inorganic sorbent in performing the efficiency of the separation.

20. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 100 30 665 as applied to claim 1 above, and further in view of Li et al (US 7,125,448). Lubda does not specifically disclose the modified inorganic monolithic being coated with a copolymer of tetraalkoxysilane and methyltrialoxysilane. Li, however, teaches a silica monolith having surface modified with at least two silanes wherein one silane is an endcapping silane (abstract, column 16, lines 25-35, and table 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to have the porous silica monolith having surface treated with the silanes as described by Li motivated by the desire to retain polar analytes reproducibly under highly aqueous conditions.

21. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 100 30 665 as applied to claim 1 above, and further in view of Ohno et al (US 4,483,940). Lubda does not specifically disclose the coating including polymer (2-hydroxyethyl methacrylate). Ohno, however, teaches a coated monolithic material comprising a silica monolith coated with polymer (2-hydroxyethyl methacrylate) (column 4, lines 10-20). The coating polymer is present in an amount of 0.02% to 10% by weight (column 4, lines 48-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymer (2-hydroxyethyl methacrylate) as a coating material for the porous silica monolith because it has been shown in the art that polymer (2-hydroxyethyl methacrylate) is a typical form of the polyacrylate that could be widely used as a coating for the silica monolith. Lubda does not specifically disclose the carbon content. However, it appears that Lubda as modified by Ohno uses the same coating material and the same concentration of the coating material as Applicants and the carbon content depends from such a concentration. Therefore, it is not seen that the carbon content could have been outside the claimed range.

22. Claims 1-5, and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 in view of Walter et al (US 7,250,214). Cabrera et al (US 6,398,962) will be relied on as an equivalent form of WO 98/58253. Assuming that

the compliant amendment in next response requires a cladding material be part of the molding. The combined teachings of Cabrera and Walter suggest the claimed subject matter. Cabrera discloses a monolithic molding for chromatographic separation made from a porous shaped SiO₂ body having interconnected macropores and mesopores in the walls of macropores wherein the macropores have an average pore size of greater than 0.1 microns and the mesopores having an average pore size of 2 nm to 100 nm (column 2, lines 20-25). The molding is coated with adsorption polymers such as styrene/divinylbenzene, methacrylic acid derivatives (column 4, lines 20-25). The moulding is columnar and has a diameter of 1 cm or greater (column 3, lines 20-22). The molding has a length of 9.3 cm (example A1). Cabrera does not teach the porous shaped SiO₂ body comprising an organic functionality integral to both the internal surface and external surface of the porous shaped SiO₂ body prior to coating with adsorption polymers. Walter, however, teaches a porous SiO₂ body having an organic functionality integral to both the internal surface and external surface before subjected to a polymeric coating (column 11, lines 55-60, column 12, lines 50-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form an organic functionality on the porous inorganic monolith prior to the surface modification motivated by the desire to impart significant improved alkaline stability to the inorganic monolith material.

23. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 in view of Walter et al (US 7,250,214) as applied to claim 1 above,

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and further in view of Dhingra et al (US 6,054,052). Cabrera does not specifically disclose the flat monolithic sorbent and its thickness. Dhingra, however, teaches a porous inorganic sorbent in the form of a flat membrane having a thickness 0.02 to 1000 microns, encompassing the claimed range (column 25, lines 1-8; column 24, lines 5-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a porous inorganic monolithic in the form of flat membrane with a thickness as taught by Dhingra because such a thickness is sufficient for the inorganic sorbent in performing the efficiency of the separation.

24. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 in view of Walter et al (US 7,250,214) as applied to claim 1 above, and further in view of Li et al (US 7,125,448). Cabrera does not specifically disclose the monolithic being modified with a copolymer of tetraalkoxysilane and methyltrialoxysilane. Li, however, teaches a silica monolith having surface modified with at least two silanes wherein one silane is an endcapping silane (abstract, column 16, lines 25-35, and table 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous silica monolith having surface treated with the silanes as described by Li motivated by the desire to retain polar analytes reproducibly under highly aqueous conditions.
25. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/58253 in view of Walter et al (US 7,250,214) as applied to claim 1 above, and further in view of Ohno et al (US 4,483,940). Cabrera does not specifically

disclose the coating including polymer (2-hydroxyethyl methacrylate). Ohno, however, teaches a coated monolithic material comprising a silica monolith coated with polymer (2-hydroxyethyl methacrylate) (column 4, lines 10-20). The coating polymer is present in an amount of 0.02% to 10% by weight (column 4, lines 48-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymer (2-hydroxyethyl methacrylate) as a coating material for the porous silica monolith because it has been shown in the art that polymer (2-hydroxyethyl methacrylate) is a typical form of the polyacrylate that could be widely used as a coating for the silica monolith. Cabrera does not specifically disclose the carbon content. However, it appears that Cabrera as modified by Walter/Ohno uses the same coating material and the same concentration of the coating material. Note that the carbon content depends from such a concentration. Therefore, it is not seen that the carbon content could have been outside the claimed range.

26. Claims 1, 2, 4, 5, 12, 16, 17, 19, and 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohno et al (US 4,483,940). Ohno teaches a coated monolithic material comprising a silica monolith coated with polymer (2-hydroxyethyl methacrylate) (column 4, lines 10-20). The coating polymer is present in an amount of 0.02% to 10% by weight (column 4, lines 48-53). It appears that Ohno uses the same coating material and the same concentration of the coating material as Applicants. Note that the carbon content depends from such a concentration. Therefore, it is not seen that the carbon content

could have been outside the claimed range. Similarly, as Ohno uses the same materials for forming the coating and the monolith, it is the examiner's position that the physical or chemical adsorption would be substantially inherently present.

Ohno does not specifically disclose the processing steps as set forth in the claims, having a cladding on the long side of the molding during the coating, impregnating with a coating solution, and the organic polymer forced through the molding under pressure and afterward lowering the temperature. However, they are product-by-process limitations not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Ohno is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in

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scope with the claims and how the Comparative Examples are commensurate in scope with Ohno. Accordingly, Ohno anticipates or strongly suggests the claimed subject matter.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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